

REMARKS

Claims 3 and 13 have been cancelled without prejudice.

Claims 1, 4-6, 11, 14-16, and 20 have been amended.

The Office objected to the drawings because a drawing labeled "Fig. 10" should have read "Fig. 1." A replacement sheet for drawing sheet 1 of 9 has been submitted now to correct the informality. No new matter has been added.

The Federal Research Statement at the beginning of the specification has been amended to correct the Department of Energy Contract Number. No new matter has been added.

The Office objected to the specification for informalities in paragraphs [0037], [0044], and [0045]. The Applicants respectfully submit that the informalities referred to in paragraphs [0037] and [0045] were really present in paragraphs [0036] and [0043]. Accordingly, the Applicants have amended paragraphs [0036], [0043], and [0044] of the specification to correct the informalities. No new matter has been added.

Independent claims 1 and 11 have been amended now to include the limitations of original, respective dependent claims 3 and 13; and a similar limitation has been added to amended independent claim 20. Accordingly, claims 3 and 13 have been cancelled without prejudice.

Dependent claims 4-6, originally depending from now canceled claim 3 have been amended now to depend from amended claim 1.

Dependent claims 14-16, originally depending from now canceled claim 13 have been amended now to depend from amended claim 11.

The Office rejected claims 1, 2 and 20 under 35 U.S.C. 102(b) as being anticipated by Maimets 5,725,026 ('026 patent). The '026 patent discloses pulling a "torpedo-shaped member" to expand the liner (Column 2 lines 3-11). Claim 1 has been amended now to add the further limitation of a "self-expandable" resilient material which is not shown nor described described in the '026 patent. Independent claim 20 has also been further amended in a similar manner to add the limitation of "expanding, due to the resiliency of the resilient material," which is also neither shown nor described in the '026 patent.

Accordingly, Applicants believe that claims 1 and 20 as amended are now allowable over the '026 patent. Since claim 2 depends from allowable claim 1 Applicants further believe claim 2 is now allowable over the '026 patent.

The Office further rejected claims 1-3 and 5-8 under 35 U.S.C. 102(b) as being anticipated by Penza 2002/0170612 ('612 publication). In paragraph 50, the '612 publication discloses using "pressure, for example an inflatable tubular bladder" to expand the liner.

As described above, claim 1 has now been amended to add the limitation of a "self-expandable" resilient material, which is not disclosed in the '612 publication. Accordingly, Applicants believe that amended claim 1 is now allowable over the '612 publication. Claim 3 has been canceled. Since claims 2 and 5-8 depend from allowable claim 1, Applicants believe that claims 2 and 5-8 are also now allowable over the '612 publication.

The Office rejected claims 1-5, 11-15 and 17-19 under 35 U.S.C. 103(a) as being unpatentable over van der Graaf 4,220,381 ('381 patent), in view of Denison 4,095,865 ('865 patent) and Maimets '026.

In order to maintain a rejection under 35 U.S.C. 103(a), all the elements of the claimed invention must be disclosed in the references. None of the '381, '865 and '046 patents disclose a self-expandable liner insertable into the central bore of a tool once the liner is inserted within the tool.

Accordingly, as described above, independent claim 1 had been amended to add the limitation of a “self-expandable” resilient material, and independent claim 11 had been amended to add the limitation of expanding the liner “due to the resiliency of the resilient material.”

Since none of the ‘026, ‘381, or 865 patents disclose a self-expanding liner or expanding a liner due to the resiliency of the resilient material, applicants therefore believe that claims 1 and 11, as amended, are now allowable over van der Graaf (‘381), in view of Denison (‘865) and Mamiets (‘026). Since claims 2, 4 and 5 depend from allowable claim 1 and claims 12, 14, 15 and 17-19 depend from allowable claim 11, Applicants believe that claims 2, 4, 5, 12, 14, 15 and 17-19 are now also allowable over these references.

The Office further rejected claims 6-9 and 16 under 35 U.S.C. 103(a) as being unpatentable over van der Graaf 4,220,381 (‘381 patent), in view of Denison 4,095,865 (‘865 patent) and Maimets ‘026 as applied to claims 3 and 13 and further in view of the Penza ‘612 publication.

Applicants believe that since dependent claims 6-9 depend from allowable claim 1 and claim 16 depends now from allowable claim 11, claims 6-9 and 16 are now allowable over these references.

The Office also rejected claim 10 under 35 U.S.C. 103(a) as being unpatentable over van der Graaf 4,220,381 (‘381 patent), in view of Denison 4,095,865 (‘865 patent) and Maimets ‘026 as applied to claim 1 and further in view of Hall et al. 6,799,632 (‘632 patent).

Applicants respectfully submit that the ‘632 patent is not available as a reference under 35 U.S.C. 103(a), as it and the present invention are commonly owned by IntelliServ, Inc., as evidenced by the recording of the assignments of both the present invention and the ‘632 patent at reel/frame No. 014718/0111.

Furthermore, since claim 10 depends from allowable base claim 1, Applicants believe claim 10 is now allowable over the remaining cited references

In view of the arguments and amendments made herein, Applicants respectfully submit that the application is now in condition for allowance. Accordingly, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Please charge Deposit Account No. 180584 in the amount of \$120, the fee required under 37 CFR 1.17(a)(1) for a one month extension for time. It is believed that there are no other fees due at this time. However, the Commissioner is hereby authorized to charge any fees which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account 180584. If there are any questions concerning the above, please contact the undersigned at 281-878-5658.

Respectfully submitted,



Jeffery E. Daly
Reg. No. 44,640

IntelliServ, Inc.
400 N. Sam Houston Prkwy East
Suite 900
Houston, TX 77060
Ph: 281-878-5658
Fax: 281-878-5720
e-mail: jeffery.daly@grantprideco.com

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